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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Edward J Kondracki
Kerkam Stowell Kondracki & Clarke
Suite 600
5203 Leesburg Pike
Falls Church, VA 22041

EXAMINER

ROCHE, TRENTON J

ART UNIT	PAPER NUMBER
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2124

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/582,701

Applicant(s)

NACHEF ET AL.

Examiner

Trent J Roche

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. This action is responsive to communications filed 28 August 2000.
2. Claims 11-37 have been examined.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in France on 30 October 1998.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 29-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims proceed to include a reference to more than one statutory class of invention. Note MPEP 2173.05(p) which states:

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph. Such claims should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

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On this basis, claim 29 is rejected. It is recommended that claim 29 be re-written to claim either a method or a computer system. For purposes of examination this will be interpreted to be a method claim. Consequently, the preambles of claims 30-34 and 35-37 should be changed from "A computer system according to claim 29" to "A method according to claim 29."

Further, claims 30-37 are rejected for being dependent on rejected independent claim 29.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 29-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Note MPEP 2173.05(p) which states:

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph. Such claims should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

On this basis, claim 29 is rejected. It is recommended that claim 29 be re-written to claim either a method or a computer system. For purposes of examination this will be interpreted to be a method claim. Consequently, the preambles of claims 30-34 and 35-37 should be changed from "A computer system according to claim 29" to "A method according to claim 29."

Further, claims 30-37 are rejected for being dependent on rejected independent claim 29.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 11-37 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent 6,237,135 to Timbol.

Regarding claim 11:

Timbol teaches:

- a method for deriving a class and/or an object having a first given name, comprising making a copy of an entire tree of the class or object as claimed (Note col. 2 lines 30-63. A copy of a first class named "Point" is created, which is given the name "myPoint" in the instantiation process. This copy has all attributes and variables of the first class. Further, note Fig. 3 and the corresponding section of the disclosure.)

Regarding claim 12:

The rejection of claim 11 is incorporated, and further, Timbol teaches a copy made through a serialization of the tree representing said class or said object as claimed ("Serializing a bean saves its state as a sequence of bytes that can be sent over a network or saved to a file." in col. 18 lines 56-57)

Regarding claim 13:

The rejection of claim 11 is incorporated, and further, Timbol teaches inheritance of the class as claimed ("By using the Base Class to Inherit From drop-down list...the user can choose a class to extend." in col. 10 lines 57-59)

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Regarding claim 14:

The rejection of claim 11 is incorporated, and further, Timbol teaches instantiation as claimed. Note the rejection regarding claim 11.

Regarding claim 15:

The rejection of claim 11 is incorporated, and further, Timbol teaches cloning as claimed. Note the rejection regarding claims 11 and 12. Instantiation, as well as Serialization, produces a clone of the parent class or object.)

Regarding claim 16:

The rejection of claim 11 is incorporated, and further, Timbol teaches automatically generating the class by means of a tool having at least one dialog box as claimed. Note Fig. 3 and the corresponding section of the disclosure.

Regarding claim 17:

The rejection of claim 16 is incorporated, and further, Timbol teaches implementing the derivation by a computer designer, and using a command interface of a computer system as claimed. Note Figures 2c – 11 and the corresponding sections of the disclosure.

Regarding claim 18-20:

The rejection of claim 12 is incorporated, and further, note the rejection regarding claims 13-15, respectively.

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Regarding claims 21-24:

The rejections of claims 12-15 are incorporated, respectively, and further, note the rejection regarding claim 16.

Regarding claims 25-28:

The rejections of claims 21-24 are incorporated, respectively, and further, note the rejection regarding claim 17.

Regarding claims 29-37:

Claims 29-37 do not further disclose or teach any new matter beyond that which is disclosed in claims 1-17, and are therefore rejected for the reasons set forth in connection with claims 1-17.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trent J Roche whose telephone number is (703)305-4627. The examiner can normally be reached on Monday-Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703)305-9662. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Anthony Nguyen-Ba

**ANTONY NGUYEN-BA
PRIMARY EXAMINER**

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Trent J Roche

Examiner

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TJR